REMARKS

Claims 108-183 were pending and presented for examination and in this application. In an Office Action dated January 24, 2008, claims 108-183 were rejected. Applicants thank the Examiner for examination of the claims pending in this application and addresses the Examiner's comments below. Based on the above Amendment and the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

Sufficiency of Written Description Under 35 USC §112, Paragraph 1

In the Office Action, claims 108-125, 151-157, and 176-183 were rejected under 35 USC §112, ¶1 as allegedly lacking written description. This rejection is respectfully traversed.

As accurately articulated by the BPAI, "the Specification need not describe the claimed subject matter in ipssis verbis," rather, the standard is whether the description "would reasonably convey to those of ordinary skill [in the art] that Appellants had possession of the claimed subject matter at the time the application was filed." Appeal 2007-1992, p. 17. Applicants submit that the specification satisfies this requirement. Applicants further note that the "claims are not to be read in a vacuum," but rather "are to be interpreted in light of the specification." MPEP 2111.01 II., citing *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976).

Applicants direct attention to the Specification at p. 5-8. The specification teaches that the claimed invention "reduces the number of purchaser interactions needed to place an order." Specification, p. 5, ll. 11-14. A unique client identifier is assigned to each client

system, the client system sends the client identifier to the server with requests to order items, and the server maps the client identifier to the client system. *See* Specification, p. 5, ll. 26. As the specification describes, when single-action ordering is enabled, e.g., as shown by the indication of the single action to be performed to place the order for the item, the purchaser *need only perform the single action* to order the item. See Specification, p. 5, l. 25 – p. 6, l. 10, p. 6, ll. 19-21, 26-28. Since only the single action need be performed, no other action – such as logging in – is necessary. This follows from the fact that the server has received the client identifier with the request to order. In contrast, when single-action ordering is <u>not</u> enabled, a single-action ordering enable button is displayed instead, and the server system may require the purchaser to log in before single-action ordering can be enabled. See Specification, p. 8, ll. 6-19. Thus, if single-action ordering is enabled, no log in is necessary. From this description, one of skill in the art would reasonably understand that no log in is required to place an order.

Therefore, Applicants maintain that claims 108-117, 124, 125, 151-155, 157, and 176-183 have adequate written description in the specification as originally filed. Claims 118-123, and 156 have been canceled.

Response to Rejection Under 35 USC §103(a)

In the Office Action, claims 108-117, 124-125, 140-147, 151-157, and 168-183 have been rejected under 35 USC §103(a) as allegedly being unpatentable over U.S. Patent 5,819,034 ("Joseph") in view of U.S. Patent No. 5,815,665 ("Teper"), and claims 118-123, 126-139, 148-150, and 158-167 rejected as allegedly being unpatentable over Joseph in view

of Teper in view of Official Notice and further in view of U.S. Patent 5,893,076 ("Hafner").
These rejections now are traversed.

In the BPAI decision, Appeal 2007-1992, the Board indicates that "there is no dispute" that Joseph and Teper "show[ ] aspects of the invention claimed in claims 108, 151, and 176, *whereby [a] user does not need to log in to the server system when ordering the item,* but needs to log in to the server system when changing previously supplied account information." 2007-1992, p. 20 (emphasis in original). Because Applicants believe that this statement is open to more than one interpretation, Applicants note that they maintain the arguments below with respect to the deficiencies of Joseph and Teper.

A. Claims 108-117, 124, 125

1. Joseph and Teper do not show "receiving from a server system a client identifier of the client system; persistently storing the client identifier at the client system."

The Office Action argues that Joseph teaches "receiving information from a server system" and "storing information persistently for transmittal to a server system" and that Teper teaches providing a unique identifier. From this, the Office Action concludes that "[i]t would have been obvious… to include in Joseph storing an identifier… as taught by Teper, because it would free up storage space on the client computer…." Office Action, p. 5. Applicants submit that the Office Action is incorrect in several respects.

First, the information that the client of Joseph *receives from the server* is stored temporarily, if at all. Joseph indicates that "no mass storage is required" and "only the currently executing portion of the program need be stored in memory." Joseph, col. 3, ll. 23-27. Further, "When the currently executing portion has completed, its memory space is freed

up." Joseph, col. 3, ll. 27-29. Thus, this information is not stored "persistently" at the client as required by the claims.

Second, the Office Action's statement that Joseph teaches "storing information persistently *for transmittal to a server system*" also is incorrect. The connection between the server and client of Joseph is a *one-way* communication path *from the server to the client*. Joseph, col. 3, ll. 1-11. Thus, there is no discussion or support in Joseph of transmitting information from the client to the server. Joseph also discloses permanent storage at the client of *client*-entered information (*see, e.g.*, col. 8, ll. 52-57). However, this information is entered in at the client, not received *from the server* as is claimed.

Next, it is alleged that Teper discloses an identifier as claimed. This is incorrect. The user ID of Teper identifies a *user* of the Teper system. *See, e.g.*, Teper, col. 2, l. 67 – col. 3, l. 4; col. 3, l. 20. In contrast, the present claims recite "a client identifier *of the client system*." That is, it identifies a client *system* 220, rather than the user or "customer" of the client system.[1] These are two different entities.

2. The suggested combination of references does not result in, and does not render obvious, these aspects of the claimed invention.

Despite the articulated differences above, even assuming *arguendo* that Joseph and Teper could be combined as suggested, the combination would not result in the claimed invention. At best it would provide either receiving from a server a *user* identifier and *temporarily* storing the *user* identifier at *a* client system, or storage of a *user* identifier *entered by a user*. This combination of Joseph and Teper does not recite at least "receiving from a server system a client identifier of the client system; [and] persistently storing [it]."

Further, the Office Action's assertion that it would be obvious to combine Joseph and Teper is misplaced. One of skill in the art would not be motivated to combine the high-speed, private, trusted two-party distributed computing system of Joseph[2] with a low bandwidth, untrusted public network such as described in Teper.[3]

Subscriber information was freely transmitted with each order using the system of Joseph because there was little risk associated with the communication. *See, e.g.*, Joseph, col. 8, ll. 56-60.[4] However, because Teper uses a system of many users creating temporary, stateless connections to multiple service providers, security concerns are paramount. *See, e.g.,* Teper, Background. Thus, the issues that the industries respectfully represented by Joseph and Teper would face would likely have little overlap, and therefore, would not look to each other for guidance.

Finally, Joseph's security teaches away from the anonymization technology described in Teper. The ordering process described in Joseph is possible *because* the connection between subscriber and provider is secure. *See, e.g.*, Teper, col. 8, l. 34 – col. 9, l. 2; Fig. 1 and accompanying text. However, combining Joseph with Teper would introduce unsecure interactions into the secure system of Joseph due to use of the Internet, which would impermissibly change the principle of operation of the Joseph reference. *See* MPEP 2143.01.

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[1] A table on the server system maps the client identifier to the customer last associated with the client system. Specification at p. 9, ll. 26-29.

[2] *See* col. 3, ll. 1-11; Abstract.

[3] Teper allows for anonymous and secure purchases of online services over untrusted public networks, such as the Internet. *See, e.g.*, Abstract. Public networks such as the Internet connect millions of computers, and thus pose significant security concerns. *See, e.g.*, Background. Low bandwidth dial up connections were predominantly used for accessing the Internet in 1997.

[4] This is because the delivery network was under the control of the server (e.g., cable TV provider), who knew the identity of the subscriber (e.g., by the transmission means 30 connected to the subscriber's home), and the subscriber always interacted with the same entity (the cable provider via the central processing facility 60). *See, e.g.*, Joseph, col. 8, l. 34- col. 9, l. 2; Fig. 1.

In addition, such a modification would take the elements of both Joseph and Teper well beyond their "established" functions, precluding the "predictability" of such combining. Thus, the discussion above indicates that the claimed invention is "more than a predictable use of [these] prior art elements according to their established functions." *See KSR*, 127 S.Ct. 1727, 1739 (2007).

> 3. Joseph, Teper, and the art at the time of the invention do not show "displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item."

The Office Action next argues that the combination of Joseph and Teper teach performing a single action to process an order by pressing a button and having instructions displayed interactively, but not displaying an indication of the single action to be performed. *See* Office Action, p. 6. In support of this argument, the Office Action cites a section of Joseph reciting pressing a TV remote control button to place an order. *Id*. No reference is made to Teper with respect to this element. In addition, Official Notice is taken that "it was old and well known in the art at the time of the invention to include instructions such as a display of an indication of a button to press to impose an executable action on a web page." Applicants disagree and traverse this Official Notice.

At the time of the invention, *i.e.*, 1997, web pages on the Internet typically used hyperlinks to impose executable actions rather than displaying an indication of which buttons to press for an action. Thus, even if one were to assume *arguendo* that the references showed what is alleged, it does not follow that it was well known in the art to display an indication of a single action that is to be performed *to order the identified item*.

Thus, that which the Examiner attempts to take Official Notice of, without the support of documentary evidence, cannot properly be categorized as "capable of instant and unquestionable demonstration as being well-known" as required to establish proper Official Notice.[5]

4. Official Notice that the suggested combination "would be obvious" is improper as not "capable of instant and unquestionable demonstration as being well-known."

Further, the Office Action attempts to "take[] Official Notice *that it would have been obvious to a person having ordinary skill in the art* to include in Joseph/Teper the displayed indication of what button to press to activate the order...." Office Action, p. 6. Applicants traverse this Official Notice as improper according to the standard articulated above. Whether the claimed elements would have been obvious to one of skill in the art is precisely what is in dispute, and thus clearly cannot be categorized as "capable of instant and unquestionable demonstration as being well-known" as required for a proper Official Notice.

In addition, Applicants disagree that it would have been obvious to apply knowledge in the art of Internet web pages to the distributed computing system of Joseph in the manner suggested in the Office Action, for the reasons indicated above regarding the combination of Joseph and Teper.

5. Joseph and Teper do not show "in response to the single action being performed, sending to the server system a request to order the identified item and the client identifier, the client identifier identifying account information of a user."

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[5] According to MPEP 2144.03: "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known."

Next, the Office Action alleges that the combination of Joseph and Teper disclose "in response to a single action being performed, sending *to the server system* a request to order the identified item along with the *client identifier*." Office Action, p. 6 (emphasis added). Again, the Office Action is incorrect.

Joseph describes, in response to pushing a button on a TV remote, that *viewer information* is appended to an item number corresponding to the item to be ordered, and is transmitted *to a central computer*. *See, e.g.*, Joseph, col. 8, l. 52 – col. 9, l. 2.[6] Joseph does not send any information, much less a client identifier, to *the server system*. *Compare* Joseph, FIG. 1. Even if the central computer 60 of Joseph could be characterized as *a* server, it is not "*the* server system" from which the client identifier was received, as is required by the antecedent basis for the present claims. Moreover, it is impossible for the client of Joseph to send any information to the server 10, because the transport mechanism 30 from the server 10 to the client computers 20 is a "one way," "unidirectional" link. *See, e.g.*, Joseph, col. 3, ll. 7-9; col. 4, ll. 28-31.

Nor does Teper remedy this shortcoming of Joseph. As with Joseph, the entity to which user information is sent when a service is accessed in Teper is not *the same* entity from which the user information is received, as required for proper antecedent basis of the present claims. Teper describes upon accessing a service, initiation of a challenge-response-authentication protocol with the SP site 50, during which information about the service requested and user information (*e.g.*, user ID and password) is sent to the SP site 50. *See, e.g.*, Teper, FIG. 3 and accompanying text. Rather, the user ID of Teper is received at the user computer 40 from the online brokering site 60. *See* Teper, col. 2, l. 65-col. 3, l. 4. The

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[6] The viewer information includes, e.g., name, address, method of payment and credit card number. *Id.*

online brokering site 60 and SP site 50 are separate, independent entities, as is necessitated by the security process of Teper. *See, e.g.*, Teper, Summary.

Thus, the discussion above indicates that the claimed invention is "more than a predictable use of [these] prior art elements according to their established functions." *See KSR*, 127 S.Ct. 1727, 1739 (2007). The suggested combination would take the cited aspects of Joseph and/or Teper beyond their "established functions," thus precluding the "predictability" of such combining. In addition, with respect to the *Graham* factual inquiries for a proper obviousness determination, Applicants note that the Office Action has not provided evidence of the level of skill in the art as suggested by the BPAI. *See* Remarks Regarding Response to Board of Appeals Remand below. Thus, claim 108, and its dependent claims 109-117, 124, and 125 are patentably distinguishable over the cited art, alone or in the combination suggested by the Examiner.

B. Claims 151-157

Claim 151 is a system claim reciting components for perfecting the method described in claim 108, and thus is, along with its dependent claims 152-155 and 157, are patentably distinguishable over the cited art for the reason discussed above. Claim 156 is canceled.

C. Claims 168-183

Claim 176 is a method claim reciting steps similar to those articulated in claim 108, from the server side perspective. As a result, claim 176, along with its dependent claims 177-183, is patentably distinguishable over the cited art for the reasons articulated above. Claims 168-175 are canecled.

Finality of Next Action Precluded

Applicants also note that for the rejection of claim 176, the Office Action says "see response to claim 108." Office Action, p. 21. Applicants note that claim 176 is not identical to claim 108, and submit that not all elements of claim 176 have been addressed. Below is a side-by-side comparison of the claims. Underlined portions represent portions of claim 176 finding no counterpart in claim 108.

CLAIM 108	CLAIM 176

A method in a client system for ordering an item, the method comprising:
    receiving from a server system a client identifier of the client system;
    persistently storing the client identifier at the client system;
    when an item is to be ordered,
        displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item; and
        in response to the single action being performed, sending to the server system a request to order the identified item along with the client identifier, the client identifier identifying account information previously supplied by a user of the client system wherein the user does not need to log in to the server system when ordering the item; and
    when account information is to be changed,
	A method in a computer for ordering an item, the method comprising:
	    providing to a client system a client identifier for the client system, the client identifier being associated with account information of a user and for persistent storage at the client system;
	    when an item is to be ordered,
	        providing to the client system a display page identifying an item, the display page including an indication of a single action that is to be performed to order the identified item;
	        receiving from the client system an indication that the user performed the single action along with the client identifier; and
	        <u>generating an order for the identified item using the account information associated with the received client identifier</u> wherein the user does not need to log in to the computer system

coordinating the log in of the user to the server system; receiving updated account information; and sending the updated account information to the server system whereby the user does not need to log in to the server system when ordering the item, but needs to log in to the server system when changing previously supplied account information.	to order the item; and when account information is to be changed, coordinating the log in of the user to the computer system; receiving from the client system updated account information; and <u>updating the account information associated with the client identifier of the logged in user based on the received updated account information.</u>

Thus, at least the limitations "generating an order for the identified item using the account information associated with the received client identifier" and "updating the account information associated with the client identifier of the logged in user based on the received updated account information" are not found in claim 108 and have not been addressed by the Examiner. Thus, the Examiner has failed to meet his prima facie burden for this additional reason. In addition, since the Examiner has <u>not addressed</u> several limitations present in the claims, Applicants submit that a next Office Action rejecting independent claim 176 and dependent claims 177-183 cannot properly be made final, since it will be the first action addressing the limitations of these claims. *See* MPEP § 706.07(a).

D. Claims 140-147 and 168-175

Claims 140-147 and 168-175 have been canceled, rendering moot the rejections of these claims.

E. Claims 118-123, 126-139, 148-150, and 158-167 further in view of Hafner

Claims 118-123, 126-139, 148-150, and 158-167 have been canceled, rendering moot the rejections of these claims.

Misinterpretation of Response to Board of Appeals Remand

The Examiner appears to have misunderstood the BPAI question regarding level of skill in the art. The Office Action articulates three questions as having been posed by the BPAI:

(1) Was it known in the authentication art not to require logging in to a server when the access device is a set top box or Webtv? Office Action, p. 32.
(2) Is there a level of skill on the webtv / set top box art regarding having to login to provide personal information for storage in a central location? Office Action, p. 34.
(3) Was it old and well known in the art at the time of the invention to log in to a remote database to update stored profiles? Office Action, p. 37.

Applicants are unclear how the Examiner came up with these questions. The *only* question posed by the BPAI was "whether one of ordinary skill in the authentication art would look to Joseph to modify an online purchasing method where no login is required and thus arrive at the claimed invention." Appeal 2007-1992, p. 20. Applicants note that the BPAI's articulation of the question frames it such that *the starting point* is an online purchasing method (i.e., akin to Teper), and whether one would look to Joseph to modify such a method. As Applicants have previously articulated, one of skill in the art would <u>not</u> be inclined to do so.

Specifically, one of skill in the art would not be motivated to combine the high-speed, private, trusted two-party distributed computing system of Joseph with a low bandwidth, untrusted public network such as described in Teper, for the reasons discussed above.

The BPAI also provided additional guidance on the question above: "[t]o resolve the level of skill in this case, the Examiner should address the facts set forth in the recent

decision in *Daiichi Sankyo Co., Ltd. V. Apotex, Inc.,* 2006-1564 (Fed. Cir., Sep. 12, 2007), pp. 3-4" (listing the six factors). This advice appears not to have been followed in the Office Action, as nowhere do these factors appear to have been addressed in the current Office Action. The BPAI indicated that addressing these factors would create a record that "include[s] evidence of the level of skill in the art and, as a result, all the *Graham* factual inquires will have been addressed and the burden of establishing a prima facie case of obviousness satisfied." Appeal 2007-1992, p. 23. Since these factors were <u>not</u> addressed, Applicants submit that a prima facie case has <u>not</u> been established.

Several times in the Response to Board of Appeals Remand section, it is argued that the elements of the cited references perform *the same function* when combined as they do in the prior art. Office Action, p. 32, 35 (twice), 36, 37. Applicants respectfully disagree in each instance.

Specifically, on p. 32 it is argued that "the recited art below teaches this feature *in the same technology as Joseph* and therefore all of the elements of the cited references perform the same function *when combined* as they do in the prior art" (emphasis added). Applicants agree that the cited art in this section (Yuen US 5,812,931; Daly US 5,878,141; Nakano US 5,845,260) *is in the same art as Joseph.* This is the result of incorrect framing of the question posed by the BPAI as whether "it [was] known in the authentication art not to require logging in to a server <u>when the access device is a set top box or Webtv?</u>" (question (1) above, emphasis added). The BPAI did not ask this question – and for good reason. Not requiring a log in, in the set top box/ web tv art, is precisely the aspect that the Examiner already relied on Joseph to show. Thus, these references provide no greater evidence as to "whether one of ordinary skill in the authentication art would look to Joseph to modify an

online purchasing method where no login is required and thus arrive at the claimed invention" – the question that *was* posed by the BPAI – than does Joseph. Further, also due to the incorrect framing of the question, the Office Action's assertion that the elements of the references "perform the same function *when combined*" is misleading. As stated, these statements must mean when combined <u>with Joseph</u>. Whether or not this is true has no affect whatsoever on whether the elements of the references perform the same function when *all* are combined, and in this instance, when combined with Teper; this is the relevant inquiry for these references, which was left unaddressed. Thus, even assuming *arguendo* that the references stand for what is alleged, the Examiner has not met his *prima facie* burden.

With respect to question (2) presented by the Examiner, a similar error was made. Here, the Office Action at least attempts to speak to the combination with Teper. The Examiner indicates that Daly "does not limit the device" and thus "could include a standard PC to server connection which [sic] is used in Teper," citing Daly, col. 6, ll. 33-55. This does not follow from Daly, which merely indicates that "many other electronic devices can be used." Daly, col. 6, l. 53. The Office Action then concludes that "all of the elements of the cited references perform the same function when combined as they do in the prior art." Office Action, p. 35. Applicants disagree. Daly recites, in a section quoted on p. 33 of the Office Action, "[d]uring the purchase transaction, the purchasing system of this invention assumes that <u>a secure communication path exists</u> between its software components on the centrally located head end server and its software components on the remotely located STB." Daly, col. 14, ll. 10-14 (emphasis added). Daly then proceeds to discuss the process by which to ensure the secure communication path.

Similar to the arguments made regarding the combination of Joseph and Teper, one of skill in the art would not look to a trusted, secure communication system such as Daly's for addressing authentication issues associated with a low bandwidth, untrusted public network such as described in Teper. And contrary to the Office Action's assertion about the elements performing the same functions, combining Daly with Teper would introduce unsecure interactions into the secure system of Daly due to use of the Internet, which would take the elements of Daly well beyond their "established functions," rendering the combination un-"predictable." *See KSR*, 127 S.Ct. 1727, 1739 (2007). In addition, such a modification would impermissibly change the principle of operation of the Daly reference. *See* MPEP 2143.01.

Nakano is a similar closed network in which the service provider and contracted home are connected by a hard-wired cable or the like. *See, e.g.,* Nakano, FIG. 3 and accompanying text. The above arguments regarding the combination of Daly and Teper apply to Nakano and Teper as well.

Demers (US 6,021,399) is relied upon as "conducting a transaction by only providing an identifier." Office Action, p. 36. Demers teaches a three-party key-based system in which a bank serves as middleman and verifier for electronic microtransactions between sellers and customers. *See, e.g.,* Demers, col. 9, ll. 25-45. Demers appears wholly unrelated to the claimed invention, and thus it is unclear how it is believed that such a system fits in with the other the cited art with respect to the claimed invention.

Schein (US 6,732,369) describes a system for providing television schedule information to a viewer, as well as information related to the content of the schedule. *See* Schein, Abstract. Schein shows ordering an item in which *a password is used to verify the*

order, in the section cited by the Examiner. *See* Schein, col. 24, ll. 65-66. No discussion was found of changing account information (the word "account" is not present in the reference). At best, Schein describes a system in which a log in *is* needed to place an order. Accordingly, it is unclear to Applicants how Schein is relevant to the level of skill in the art with respect to the claimed limitation pertaining to *not* needing to log in to place an order.

Applicants submit that the Office Action's interpretation of the BPAI's questions, and these additional references, do not provide clarification of the level of skill in the art as instructed by the BPAI. Thus, Applicants submit that the Examiner still has not met his *prima facie* burden for a showing of obviousness under 35 USC §103(a).

Conclusion

In sum, Applicants respectfully submit that claims 108-117, 124, 125, 151-155, 157, and 176-183, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,

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